

**REMARKS**

Please reconsider the application in view of the above amendments and the following remarks.

**Interview and Claim Amendments**

The Applicant thanks the Examiner for the interview of February 6, 2003 ("the Interview"). During this interview a preliminary agreement was reached that the amendment of the independent claims to recite that the orthopedic apparatus is positioned substantially "under the phalanges" of a toe would suffice to overcome the § 112 indefiniteness rejection as well as the § 102 and § 103 rejections over the Liley and Epstein references. Accordingly, the claims have been amended in accordance with this preliminary agreement in order to place the application in condition for allowance.

Other minor amendments were made to the claims to correct spelling errors and to maintain a consistent claim scope. No new matter has been added by way of these amendments.

**Rejections under 35 U.S.C. § 112**

Claims 1-23 were rejected as being indefinite. To the extent that this rejection applies to the amended claims, it is respectfully traversed. Independent claims 1, 10, and 18 have been amended to recite that the orthopedic apparatus is positioned substantially under the phalanges of a toe. As discussed in the Interview, this language is believed to clarify any indefiniteness with regard to the position of the apparatus. Claims 2-9, 11-17, and 19-23 depend from claims 1, 10, or 18, and are thereby similarly cured of indefiniteness.

Claims 16 and 17 were also amended to depend from the appropriate claim, thereby correcting the improper antecedent basis noted by the Examiner.

Accordingly, withdrawal of this rejection is respectfully requested.

**Rejections under 35 U.S.C. § 102**

Claims 1, 3-5, 10, 11, 13, and 15 were rejected as being anticipated by U.S. Patent No. 6,098,319, issued to Epstein. To the extent that this rejection applies to the amended claims, it is respectfully traversed.

As previously discussed, claims 1 and 10 have been amended to recite that the orthopedic appliance is located substantially under the phalanges of a toe. In contrast, Epstein discloses a circular balancing appliance that may be rotated and oriented under a foot in order to compensate for a lack of balance. Epstein neither discloses nor suggests the use of the balancing appliance with the phalanges of a toe. Therefore, claims 1 and 10 are patentably distinct over Epstein. Claims 3-5, 11, 13, and 15 depend from claims 1 and 10, respectively, and are similarly patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

#### **Rejections under 35 U.S.C. § 103**

Claims 18-23 were rejected as being obvious over Epstein. To the extent that this rejection applies to the amended claims, it is respectfully traversed.

As previously discussed, claim 18 has been amended to recite that the orthopedic appliance is located substantially under the phalanges of a toe. In contrast, Epstein discloses a circular balancing appliance that may be rotated and oriented under a foot in order to compensate for a lack of balance. Epstein neither discloses nor suggests the use of the balancing appliance with the phalanges of a toe. Therefore, claim 18 is patentably distinct over Epstein. Claims 19-23, which depend from claim 18, are similarly patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 1-5, 10-13, and 18-23 were rejected as being obvious over U.S. Patent No. 6,182,380, issued to Liley, in view of U.S. Patent No. 6,092,314, issued to Rothbart. To the extent that this rejection applies to the amended claims, it is respectfully traversed.

Amended claims 1, 10, and 18 recite an orthopedic apparatus positioned substantially under the phalanges of a toe. In contrast, Liley discloses a stackable demi pointe equalizer that extends past the metatarsals of the foot (Col. 4, lines 9-10). Liley neither discloses nor suggests a wedge-shaped orthopedic appliance positioned substantially under the phalanges of a toe.

Rothbart discloses a foot support system that extends as far as the one-five metatarsal parabola. Rothbart fails to compensate for the deficiencies previously noted in Liley, namely a wedge shape and a position substantially under the phalanges of a toe.

Amended claims 1, 10, and 18 have been shown to be patentable over the combination of Liley and Rothbart. Claims 2-5, 11-13, and 19-23, which depend from claims 1, 10, or 18, are similarly patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 7-9 and 15-17 were rejected as being obvious over U.S. Patent No. 6,182,380, issued to Liley, in view of U.S. Patent No. 6,092,314, issued to Rothbart, and further in view of either U.S. Patent No. 4,745,927, issued to Brock, or U.S. Patent No. 4,940,046, issued to Jacoby. To the extent that this rejection applies to the amended claims, it is respectfully traversed.

As previously discussed, neither Liley nor Rothbart, alone or in combination, discloses or suggests the orthopedic apparatus of amended claims 1 and 10. Brock and Jacoby fail to compensate for the deficiencies noted in Liley and Rothbart. Accordingly, these claims are patentable over the combination of these references. Claims 7-9 and 15-17, which depend from independent claims 1 and 10, respectively, are similarly patentable for at least the same reasons. Therefore, withdrawal of this rejection is respectfully requested.

### **Conclusion**

Claims 1-23 have been shown to be allowable over the prior art. Applicant believes that this paper is responsive to each and every ground of rejection cited by the Examiner in the Action dated December 13, 2002, and respectfully requests favorable action in the form of a Notice of Allowance. If this belief is in error, or other issues arise, please do not hesitate to contact the undersigned or one of his associates at the number below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 09166.002001).

Respectfully submitted,

Date: 2/13/03

  
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